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10/037,378	10/23/2001	Matthew Rosenhaft	4S04.1-012	6799

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/037,378

Applicant(s)

ROSENHAFT ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/25/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the amendment filed on January 26, 2005. Claims 1-31 are pending. Claims 21 is amended.

### ***Response to Arguments***

2. Applicant's arguments filed January 26, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument about the 112 2<sup>nd</sup> paragraph rejections, examiner respectfully disagrees. Although applicant presented statutory subject matter in claim 20 and claim 30, the limitations are ambiguous because they claimed both "system" and method"; thus, the 112 2<sup>nd</sup> paragraph rejections are sustained.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Shah - U. S. Patent 6,029,065 teaches requiring programming of the mobile station which is fundamentally different from the current application that requires no preprogramming of the mobile station) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 20 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 20 and 31, applicant claims both "system" and "method". Applicant should either rewrite the claim to independent system claims, or cancel the claims.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 6, 9-13, 16-23 and 26-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Shah, U. S. Patent 6,029,065.

As to claim 1, Shah teaches a method for implementing a telecommunications initiated data fulfillment system comprising the steps of (abstract and Fig. 4):

- a) receiving a communication comprising an input sequence including a multifunction key sequence from a telecommunications device (column 9 line 55 – column 10 line 23);
- b) recognizing the multi-function key sequence as a trigger code (column 9 line 55 – column 10 line 23 and column 11 lines 6-8);
- c) identifying an identification code associated with the telecommunication device (column 9 line 55 – column 10 line 23 and column 11 lines 6-9);

- d) looking up a pre-defined data address associated with the input sequence, the identification code, or a combination of the input sequence and the identification code (column 9 line 55 – column 10 line 23 and column 11 lines 6-9);
- e) assembling a data message associated with the input sequence, the identification code, or a combination of the input sequence and the identification code (column 9 line 55 – column 10 line 23 and column 11 lines 6-11);
- f) transmitting the data message to the data address (column 9 line 55 – column 10 line 23 and column 11 lines 6-11);
- g) implementing a response action in response to the data message (column 11 lines 11-19 and Fig. 4).

As to claims 2 and 26, Shah teaches the steps of:

- a) using the identification code to identify an account associated with the telecommunications device (column 10 lines 11-19; specifically, “the identification code” corresponds to the phone number that the user entered in Shah’s teaching);
- b) charging a cost associated with the data message to the account associated with the telecommunications device (column 7 lines 56-60 and column 11 line 51 – column 12 line 3).

As to claim 6, Shah teaches delivering an audio or data response to the telecommunications device; and discontinuing the communication (column 8 lines 31-43 and column 11 line 51 – column 12 line 3).

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As to claims 9 and 27, Shah teaches receiving location data associated with the telecommunications device; and customizing an action taken in response to the data message based on the location data (column 11 lines 6-22 and column 11 line 51 – column 12 line 3).

As to claims 10 and 28, looking up customer profile data corresponding to the identification code associated with the telecommunications device, and wherein the pre-defined data address comprises a user-defined portion of the customer profile data are taught by Shah as the network or the base station receives the user input sequence, and uses the input sequence to determine if the user is within or outside the home network (column 6 line 39 – column 7 line 17 and column 10 lines 11-24).

As to claims 11 and 29, Shah teaches detecting that the telecommunications device does not correspond to a subscriber of the telecommunications initiated data fulfillment service; and automatically linking the telecommunications device to a platform configured to register the user of the telecommunications device as a subscriber of the telecommunications initiated data fulfillment service (column 6 line 39 – column 7 line 17).

As to claim 12, Shah teaches the pre-defined data address is retrieved from a home location register associated with a mobile telephone; and the data message is delivered to the data address through a signaling system message (column 6 lines 27-38 and column 10 lines 11-19 and column 8 lines 17-31 and Figs. 1-4).

As to claim 13, Shah teaches the identification code associated with the telecommunication device is extracted from a call detail record created by a telecommunications switch receiving the communication; and the pre-defined data

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address is retrieved from a proprietary database maintained by a provider of the telecommunications initiated data fulfillment service (column 2 lines 9-45).

As to claim 16, Shah teaches a telecommunications switch (*Mobile Switching Center 302 of Fig. 1*) receives the communication from the telecommunications device; the telecommunications switch creates the data message; the data message includes the input sequence and a directory number associated with the telecommunications device; the telecommunications switch transmits the data message to a data fulfillment platform (*Visitor Location Register 306 of Fig. 1*); and the data fulfillment platform responds to the data message (column 2 lines 9-48 and column 10 lines 11-19 and Fig. 1).

As to claims 17-18, Shah teaches the data message comprises information derived from a call detail record or an in-process call detail record (column 2 lines 9-48 and Fig. 1; *specifically, "call detail record" corresponds to the information stored in the Home Location Register in Shah's teaching*).

As to claim 19, Shah teaches wherein the telecommunications switch transmits as a signaling system message (column 2 lines 9-48 and Figs. 1-3).

As to claim 20, Shah teaches a system configured to perform the method of claim 1 (see claim 1 above and Figs. 1-4).

As to claim 21, Shah teaches a method for implementing a telecommunications initiated data fulfillment service comprising the steps of (abstract and Fig. 4):

- a) entering an input sequence including a multi-function key sequence using a telecommunications device (column 9 line 55 – column 10 line 23);

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b) receiving a communication comprising the input sequence at a telecommunications switch (*Mobile Switching Center 302 of Fig. 1*), and at the switch (column 2 lines 9-35 and column 9 line 55 – column 10 line 23):

- recognizing the multi-function key sequence as a trigger code (code (column 9 line 55 – column 10 line 23 and column 11 lines 6-8),
- holding the communication (Figs. 4-5),
- looking up an instruction set identified by the input sequence (column 9 line 55 – column 10 line 23 and column 11 lines 6-9),
- delivering an audio or data message to the telecommunications device (communication (column 8 lines 31-43 and column 11 line 51 – column 12 line 3),
- discontinuing the communication (communication (column 8 lines 31-43 and column 11 line 51 – column 12 line 3),
- identifying an identification code associated with the telecommunications device (column 9 line 55 – column 10 line 23 and column 11 lines 6-9),
- assembling a data message comprising the input sequence and the identification code (column 9 line 55 – column 10 line 23 and column 11 lines 6-11),
- transmitting the data message (column 9 line 55 – column 10 line 23 and column 11 lines 6-11);



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c) receiving the data message at a data fulfillment center, and at the data fulfillment center (*Visitor Location Register 306 of Fig. 1*): identifying a response action associated with the data message, and implementing the response action (column 2 lines 9-48 and column 9 line 55 – column 10 line 23 and column 11 lines 6-9 and column 11 line 51 – column 12 line 3 and Fig. 1).

As to claims 22-23, the claims are rejected for the similar reasons as claims 16-18.

As to claim 30, Shah teaches the response action comprises the step of transmitting a control signal to operate a remote device (Figs. 1-5).

As to claim 31, Shah teaches a system configured to perform the method of claim 21 (see claim 21 above).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5, 7-8, 14-15 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah, U. S. Patent 6,029,065 in view of Kolls, U. S. Patent 6,763,336.

As to claim 3, Shah teaches implementing a response action in response to the data message as discussed above. Shah does not specifically teach activating a vending device in response to the data message. However, Kolls teaches remotely

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activating a vending device (abstract and column 6 line 45 – column 7 line 67 and column 10 line 51 – column 11 line 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Shah's teaching to include the feature of activation a vending device as taught by Kolls for conveniently controlling remote devices.

As to claim 4, Shah teaches identifying a product code from a predefined set of digits in the input sequence; and activating the user's device to deliver a product associated with the product code in response to the data message (column 9 line 55 – column 10 line 24 and column 11 lines 6-11 and column 11 line 51 – column 12 line 3). Shah does not specifically activating a vending device to deliver a product associated with the product code. However, Kolls teaches remotely activating a vending device to deliver a product that is requested by the user (abstract and column 6 line 45 – column 7 line 67 and column 10 line 51 – column 11 line 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Shah's teaching to include the feature of activation a vending device to delivery a product associated with the product code as taught by Kolls for conveniently controlling remote devices.

As to claim 5, looking up a pre-defined personal identification number associated with the telecommunications device, identifying a PIN-sequence from a predefined set of digits in the input sequence, and comparing the personal identification number to the PIN-sequence are taught by Shah as based on the user input sequence number to determine if the user is within or outside the home network (column 6 line 39 – column 7 line 17 and column 10 lines 11-24).

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As to claims 7-8 and 24, Shah teaches the input sequence comprising a directory number associated with a service request, and responding the data message by initiating the service request between telecommunications device and the service provider, and forward the communication to a platform operated by the service provider (column 10 lines 11-24 and column 11 lines 6-11 and column 11 line 51 – column 12 line 3). However, Shah does not specifically teach the service request is an Internet site. However, Kolls teaches the service request including an Internet related service (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the service request in Shah's teaching to include an Internet related service as taught by Kolls for expanding the usage environment of Shah, thus to attract more user's to use Shah's teaching.

As to claim 14, Shah teaches responding to the data message by transmitting a control signal to operate the telecommunication device as discussed above. Shah does not specifically teach transmitting the control signal to operate a remote device. However, this matter is taught by Kolls as transmitting control signal to operate a vending device remotely (abstract and column 6 line 45 – column 7 line 67 and column 10 line 51 – column 11 line 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Shah's teaching to include the feature of transmitting control signal for operate a remote device as taught by Kolls for expanding the usage environment of Shah, thus to attract more user's to use Shah's teaching.

As to claims 15 and 25, Shah teaches the input sequence comprises a displayed item code associated with a service offered for sale, further comprising the steps of responding to the data message by: looking up an address associated with the

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telecommunications device; and responding to the data message by transmitting an electronic message to the address associated with the telecommunications device (column 10 lines 11-24 and column 11 lines 6-11 and column 11 line 51 – column 12 line 3). Shah does not specifically teach the address is an email address and the electronic message including promotional information concerning the product or service offered for sale. However, Kolls teaches these matters (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the address in Shah's teaching to be an email address and the electronic message includes promotional information concerning the product or service offered for sale because this would allowing the service provider to efficiently distribute information for better promoting product or service sales.

### ***Conclusion***

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is 571-272-6705. The examiner can normally be reached on M-Th (10:00-7:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Cheung  
Patent Examiner  
Art Unit 3621  
April 26, 2005

